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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85574542
Applicant	Ebab Arfeh
Applied for Mark	THE CRAFTS OUTLET
Correspondence Address	MATTHEW H SWYERS THE TRADEMARK COMPANY 344 MAPLE AVENUE WEST, SUITE 151 VIENNA, VA 22180 UNITED STATES admin@thetrademarkcompany.com
Submission	Request to Bifurcate
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Filer's Name	Matthew Swyers
Filer's e-mail	mswyers@TheTrademarkCompany.com
Signature	/Matthew H. Swyers/
Date	05/26/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The Trademark Trial and Appeal Board

In re Application of:

Ebab Arfeh

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Serial No.: 85574542

Examining Attorney: Asmat Khan

Filed: March 20, 2012

Law Office: 114

Mark: THE CRAFTS OUTLET

Motion to Bifurcate Response to Refusal

COMES NOW Ebab Arfeh (hereinafter the “Applicant”)by counsel, The Trademark Company, PLLC, and submits the instant motion requesting the Board to allow the Applicant to bifurcate its response to the Examining Attorney’s refusal of Registration. On the grounds and as more fully set forth below, the applicant believes it is in the interests of fairness and of efficiency to allow a bifurcated response to the refusal of registration.

Generic Refusal and “Refusal in the Alternative”

The Examining Attorney has issued a refusal to register the mark on the grounds that it is generic of the services offered by the Applicant. The final refusal contains a “refusal in the alternative” which states:

“In the alternative, if the applied-for mark is ultimately determined not to be generic by an appellate tribunal, then the refusal of registration based on the applied-for mark being merely descriptive of applicant’s services is maintained and continued for the reasons specified in the previous Office action. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*”

The Applicant respectfully thus requests that the Board bifurcate the appeal in this regard to first consider and rule upon the generic refusal and then, if the mark is determined not to be generic,

to remand the application for further consideration by the examining attorney as to the issue of mere descriptiveness.

The basis for the Applicant's request is one of fundamental fairness. In short, although an Examining Attorney is permitted to refuse in the alternative, rarely do we see that to be the case in the form of a combined generic and/or merely descriptive refusal. As the Board is aware, if a refusal is affirmed on appeal the Applicant may not subsequently request remand to cure the refusal if, for instance, it wishes to seek registration on the Supplemental Register to avoid a merely descriptive refusal.

At present, the Examining Attorney has refused the trademark on the grounds it is (1) generic and (2) merely descriptive. In doing so, the examining attorney has created a procedural roadblock that, in the interests of justice, should be removed by the Board.

By arguing that the trademark is generic, the Examining Attorney will not allow the Applicant to overcome the refusal by amending to seek registration on the Supplemental Register if the Applicant wanted to do so. However, if the refusal as written moves forward with both the generic and merely descriptive arguments being heard, even if the Applicant is victorious in establishing that the trademark is not generic but the Board finds it to be merely descriptive the Board will not allow the Applicant to remand the application to seek registration on the Supplemental Register. In short, by issue these two refusals in conjunction with one another the Examining Attorney has virtually assured itself of a procedural, not substantive, victory in the instant matter.

As such, Applicant respectfully moves the Board for an order bifurcating the instant appeal to allow for the primary refusal, that the mark is alleged generic, to be heard first, and if it

is held not to be generic for the matter to be remanded to the Examining Attorney to determine how to then deal with the merely descriptive refusal in light of the Board's order concerning the generic issue.

Respectfully submitted this 26th day of May 2015.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

Matthew H. Swyers, Esq.

344 Maple Avenue West, PMB 151

Vienna, VA 22180

Tel. (800) 906-8626

Facsimile (270) 477-4574

mswyers@thetrademarkcompany.com

Counsel for Applicant